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Department of the United States  
Justice

MEMORANDUM FOR THE ATTORNEY GENERAL

RE: [REDACTED]

1. [REDACTED]

2. [REDACTED]

Very truly yours,  
[REDACTED]

JOHN F. ROBERTS  
DEPUTY ATTORNEY GENERAL

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100-443888-1000

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No. 95-26

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IN THE  
SUPREME COURT OF THE UNITED STATES  
OCTOBER TERM 1995

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MARKMAN, et. al.

*Petitioners*

v.

WESTVIEW INSTRUMENTS, et. al.

*Respondents*

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ON WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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BRIEF FOR AMICUS CURIA, JOHN T. ROBERTS  
SUGGESTING AFFIRMANCE

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## OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit ("Federal Circuit") is reported at 52 F.3d 967. The decision of the United States District Court for the Eastern District of Pennsylvania ("District Court") is reported at 20 USPQ2d 1955.

## INTEREST OF AMICUS

Amicus files this brief to bring to the attention of the Court certain matters, believed to be relevant, which are outside the record below. For this reason, it is believed neither the parties, nor other amici will address these matters. The brief is submitted with the written consent of the parties, filed herewith.

Amicus takes no position on the merits of this case. The suggestion for affirmance is limited to the fact that 11 of 12<sup>1</sup> judges below decided the correct answer to the issue presented (Does the claimed term "inventory" cover "cash"), was NO. Should a majority of this Court reach an opposite conclusion, then amicus would suggest a reversal.

The interest of amicus is that of a patent lawyer, who believes that properly limited patents do indeed serve the public interest, but do not do so when extended to cover devices not invented by the patentee.

## SUMMARY OF ARGUMENT

In the normal patent case there is only one infringement question. To construe the claim is to decide who wins the infringement issue. In the early days of the United States, trial judges have gave infringement instructions which amounted to a directed verdict, when

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<sup>1</sup> The 12th Judge did not explicitly disagree, but urged the case should be returned to the District Court to add the rather clearly implied statement that he found "there was no substantial evidence..."

there was no question of the accused structure and the only question was the construction of the claims. Patent jury cases are becoming more common, and juries vote overwhelmingly that patents are infringed. For over a century Congress has required a patent to "distinctly claim" the invention; and this Court has stated that Courts cannot enlarge the patent beyond the scope of the claims. The actions of juries are often in conflict with those historic limitations on patent rights.

## ARGUMENT

### 1. THE CONSTRUCTION OF THE CLAIM IS USUALLY THE ONLY INFRINGEMENT QUESTION

The Federal Circuit opinion includes the now mandatory statement that infringement analysis entails two steps, (first, determining the meaning and scope of the patent claims; second comparing the construed claim to the accused device).

No amount of repetition makes this statement universally true. Indeed it is generally untrue. In the majority of the cases, and this appears to be one, the construction of the claim is the only infringement issue. As expressed by Judge Mayer below at 989:

"...to decide what the claims means is nearly always to decide the case."



Take two instances famous in history. In each of these cases, the only infringement question was:

"Does the Morse patent cover the Colombian (O'Reilly) Telegraph which uses marks and signs differing from the Morse Code?"<sup>2</sup>

"Does the Wright patent cover an aeroplane in which the pilot may sometimes regain level flight without rudder control?"<sup>3</sup>

In neither case did the court formulate the issue exactly in these words, and the above questions may oversimplify. They illustrate the point however that deciding what the claim means decides who wins the case.

When there is no issue about the actual structure<sup>4</sup> of the accused device, there is only the one question. Usually, if not nearly always, there is no issue about the accused structure. There was no issue about the structure of the Columbian telegraph, Glen Curtiss' aeroplane, or any of the accused devices in the cases in the next section.

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<sup>2</sup> This Court thought so in *O'Reilly et al. v. Morse, et al.*, 56 U.S. 62 (1853).

<sup>3</sup> Five Judges thought so, (including a young District Judge, Learned Hand, in a companion case) see *Wright v. Herring Curtiss*, 211 Fed. 564 (2nd Cir. 1914). Despite this decision, the Wrights had more difficulty enforcing their United States patent than their European patents, and but for World War II, the Wright Flyer might today still be in England.

<sup>4</sup> or composition or process

As there is only one question, the next issue is who decides that question. It is simply not something which can be bifurcated. If the jury could have decided the Morse patent did not cover telegraphs using signs different from the Morse Code, they and they alone would have decided the entire issue.

## 2. IN THE 1800'S, COURTS GAVE INSTRUCTIONS ON THE CONSTRUCTION OF PATENTS WHICH WERE DIRECTED VERDICTS.

In *Prouty and Mears v. Ruggles*, 41 U.S. (16 Pet.) 336, 340 (1842) the Circuit Judge had instructed the jury:

"That upon the true construction of the patent, it is for a combination, and a combination only. That the combination ... consists of three things..."

This was a single issue case, as the patentee had asked for an instruction that two elements were enough, and the defendant offered no evidence. The jury duly found for the defendant, and this Court affirmed.

In *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1853) the Circuit Judge had instructed the jury:

"That the machine used by defendant is an infringement (if it operates by the same process although it differs in construction)"

There was no disputed fact. The defendants machine differed from that disclosed in the patent in construction although it operated by the same process (converting puddlers' balls into blooms...!). This Court felt this was a

single issue case, where a preclusive instruction was proper.<sup>5</sup>

In *Seymour et al. v. McCormick*, 60 U.S. (19 How.) 96 (1856) the Circuit Judge had instructed the jury that Claim 2 of the 1845 patent was for teeth and fingers for seizing the grain. The jury returned a verdict<sup>6</sup> as instructed and this Court affirmed.

In *Case v. Brown*, 69 U.S. (2 Wall.) 320 (1864) the Circuit Judge had instructed the jury, "...The plaintiff cannot claim double dropping (of a seed planter), that is a result or effect." The jury duly returned a verdict for defendant, and the patentee appealed on the ground that the Judge had withdrawn the "question of fact"<sup>7</sup> from the jury (the same result). Justice Grier affirmed stating:

"The instruction there quoted is a correct exposition of the law, and if it produced a verdict in favor of the defendant, the plaintiff has no right to complain."

In *Garratt v. Seibert*, 131 U.S. cxv (1874) the Circuit

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<sup>5</sup> This Court felt that the instruction should have been "not an infringement", as it held that processes were not patentable. In due time this Court agreed with the Circuit Judge on this point also.

<sup>6</sup> The verdict was for the patentee, as the defendant was urging a broader construction, to avoid costs, if the patent contained an (unasserted) invalid claim.

<sup>7</sup> This brief has consciously refrained from using the terms "question of fact" or "question of law" as they appear to obscure, not illuminate, the issues presented. As used above, the term simply assumes the desired result, an example of circular reasoning.

Judge instructed the jury that claim 2 covered only the lubricator and did not include the heating apparatus, also disclosed in the patent. The jury found the defendant, who used the lubricator only, to infringe.

Justice Strong stated that the question presented was whether Claim 2 included the heating apparatus an part of the combination. He then stated that the answer to that question determined whether or not there was an infringement. The Court then construed the claim and affirmed the judgement.

In each of these cases, there was a "one issue" infringement question. In each of them, the trial judge instructed the jury in a manner which directed a single verdict. In each of these cases, this Court approved of this type of instruction.

Necessarily, this Court believed that in each of these cases, the only infringement question, the scope of the claim, belonged solely in the province of the trial court, and not to the jury.

Amicus suggests, based on the Federal Circuit decisions, and the District Court opinion, the above "one step" analysis applies here, as there is no doubt about the accused structure. Amicus further suggests that this Court should limit its decision to this classic and usual situation, and not attempt to formulate a universal rule, applicable to all cases, including the minority, where there may be doubt about the structure of the accused device.



The results of the last 15 years show that juries cannot be relied on to perform this function of determining the proper scope of patent claims.

### 3. JURIES VOTE OVERWHELMINGLY THAT PATENTS ARE INFRINGED.

In the past 15 years, juries have returned infringement verdicts over 200 times.<sup>8</sup> Of these the juries have found that the patents are infringed 85% of the time,<sup>9</sup>

<sup>8</sup> The list, verdicts from about 1980 to 1993, has been compiled by the author and his associates over several years. The number of entries today stands at 186.

<sup>9</sup> Patents Jury Found Infringed "patent (source)"  
3,900,886 (CA CV 90-2323); 3,351,836 (ED Mich CA 78-70740); 3,574,374 (ED Mich CA 78-70740); 3,581,178 (ED Mich CA 78-70740); 3,582,747 (ED Mich CA 78-70740); 3,602,790 (ED Mich CA 78-70740); 3,796,936 (ED Mich CA 78-70740); 3,875,401 (D Minn CA 87-4847; 88-1624); 4,002,899 (D Minn CA 87-4847; 88-1624); 3,860,935 (D Minn. CA 87-4847; 88-1624); Re.29,599 (D Minn. CA 87-4847; 88-1624); ??? (1987 US Dist LEXIS); 4,166,388 (1993 US App LEXIS 1915); 4,497,520 (1991 US Dist LEXIS 15891); 4,900,171 (1992 US Dist LEXIS 752); ??? (20 USPQ2d 1367); ??? (15 USPQ2d 1159); ??? (15 USPQ2d 1154); 3,342,422 (8 USPQ2d 1669); 3,351,836 (31 USPQ2d 1746); 3,462,964 (11 USPQ2d 1735); 3,498,621 (5 USPQ2d 1535); 3,574,374 (31 USPQ2d 1746); 3,581,178 (31 USPQ2d 1746); 3,602,790 (31 USPQ2d 1746); 3,659,915 (19 USPQ2d 1838); 3,664,269 (28 USPQ2d 1352); 3,702,076 (15 USPQ2d 1453); 3,807,409 (8 USPQ2d 1299); 3,864,102 (11 USPQ2d 1375); 3,877,307 (15 USPQ2d 1453); 3,941,993 (15 USPQ2d 1241); 3,952,311 (32 USPQ2d 1603); 4,149,513 (26 USPQ2d 1401); 4,198,756 (12 USPQ2d 1081); 4,254,529 (13 USPQ2d 1607); 4,301,040 (12 USPQ2d 1916); 4,330,280 (25 USPQ2d 1870); 4,374,798 (19 USPQ2d 1881); 4,384,853 (25 USPQ2d 1870); 4,391,590 (25 USPQ2d 1870); 4,438,842 (15 USPQ2d 1074);

4,450,512 (2 USPQ2d 1779); 4,459,302 (20 USPQ2d 1836); 4,529,034 (14 USPQ2d 1210); 4,549,302 (20 USPQ2d 1836); 4,554,574 (27 USPQ2d 1784); 4,592,353 (29 USPQ2d 1533); 4,600,014 (32 USPQ2d 1040); 4,694,244 (29 USPQ2d 1533); 4,703,173 (22 USPQ2d 1551); 4,736,743 (29 USPQ2d 1533); 4,787,938 (21 USPQ2d 1321); 4,798,729 (31 USPQ2d 1173); 4,844,957 (22 USPQ2d 1551); 5,017,391 (31 USPQ2d 1173); Re.33,206 (27 USPQ2d 1521); 3,190,326 (229 USQP 43); 3,247,736 (223 USQP 533); 3,282,312 (229 USQP 43); 3,459,199 (218 USQP 31); 3,674,562 (216 USQP 687); 3,860,003 (227 USQP 786); 3,973,282 (218 USQP 433); 4,243,864 (230 USQP 501); 5,015,516 (156 FRD 806); 4,165,184 (5 F.3d 1557); 4,318,619 (5 F.3d 1557); 3,660,163 (547 F.Supp. 401); 3,837,292 (579 F.Supp. 353); 3,246,751 (593 F.Supp. 1275); 3,609,694 (593 F.Supp. 1275); 4,065,264 (611 F.Supp. 964); 4,138,288 (611 F.Supp. 964); ??? (614 F.Supp. 1368); 3,789,832 (630 F.Supp. 581); ??? (678 F.2d 746); 3,966,396 (679 F.2d 1023); Re.27,757 (696 F.Supp. 1033); 4,029,401 (703 F.Supp. 408); ??? (704 F.2d 1133); 4,034,918 (713 F.2d 1347); 3,524,680 (723 F.2d 1553); 4,066,423 (736 F.2d 666); 3,319,515 (739 F.2d 604); 3,644,125 (744 F.2d 797); 4,117,644 (744 F.2d 797); 4,197,194 (748 F.Supp. 1078); 3,843,051 (749 F.2d 707); 4,117,977 (749 F.2d 707); 4,363,820 (757 F.Supp. 1030); 4,545,933 (757 F.Supp. 1030); 4,600,588 (757 F.Supp. 1030); 4,814,688 (757 F.Supp. 1088); 4,831,282 (757 F.Supp. 1088); 4,905,189 (757 F.Supp. 1088); 3,904,506 (758 F.2d 613); 3,925,182 (758 F.2d 613); 4,544,203 (774 F/S 1277); 4,305,467 (774 F.2d 478); 3,846,347 (787 F.2d 1545); 4,248,975 (787 F.2d 1545); 3,535,844 (797 F.2d 1504); 4,752,603 (798 F.Supp. 213); 4,766,075 (798 F.Supp. 213); 4,853,330 (798 F.Supp. 213); 3,901,501 (799 F.2d 734); 3,815,586 (806 F.2d 1565); Re.30,867 (806 F.2d 1565); 4,245,343 (813 F.2d 1196); 4,310,343 (814 F.2d 628); 3,918,565 (818 F.Supp. 707); 4,376,328 (827 F.2d 1524); 4,378,600 (827 F.2d 1524); 4,221,071 (847 F.2d 1573); 3,803,660 (849 F.2d 585); 4,846,326 (855 F.Supp. 1101); 3,414,254 (862 F.2d 283); 3,485,120 (862 F.2d 267); 3,907,332 (868 F.2d 1226); 3,736,968 (872 F.2d 978); 3,746,656 (872 F.2d 978); 3,825,960 (873 F.2d 1422); 3,833,948 (873 F.2d 1422); 4,109,844 (888 F.2d 815); 4,560,168 (904 F.2d 676); 4,062,141 (927 F.2d 1552); 4,024,535 (932 F.2d 939); 4,185,167 (932 F.2d 939); 3,941,082 (952 F.2d 1320); Re.32,106 (968 F.2d 1202); 4,286,925 (984 F.2d 410); Re. 32,292 (991 F. 2d 753); 4,656,605 (993 F.2d 858); 4,727,513 (993 F.2d 858); 5,550,540 (24 USPQ2d 1493);

and not infringed 15% of the time<sup>10</sup>.

Two questions are presented by this information. The first is whether the sample is valid or biased. Excluded are all jury cases settled after verdict but before appeal, except those few known to the compilers. There are surely 20, but probably not 50 of these verdicts. There are probably a dozen more verdicts, where some reference is contained in some reported (but unfound) opinion. If the omitted verdicts vary in percentage at all from the listed ones, the percentage of the total patents found infringed would not appear to change substantially.

The second question presented is what is the significance of this information<sup>11</sup> to the Court in this case. There might be little significance, but for the first point

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4,103,001 (231 USQP 593)

<sup>10</sup> Patents Jury Found Not Infringed "patent no. (source)"

4,029,401 (703 F.Supp. 408); 3,581,399 (12 USPQ2d 1081); 3,709,231 (12 USPQ2d 1554); 4,195,862 (31 USPQ2d 1526); 4,333,660 (14 USPQ2d 1077); 4,392,553 (3 USPQ2d 1876); 4,684,150 (31 USPQ2d 1526); 5,044,659 (31 USPQ2d 1526); 5,098,117 (31 USPQ2d 1526); 5,581,399 (12 USPQ2d 1081); 3,748,015 (216 USQP 760); 3,821,763 (216 USQP 760); 3,910,434 (216 USQP 563); Re.31,904 (5 F.3d 1557); 3,709,231 (718 F.Supp. 1403); 4,110,210 (730 USQP 753); 4,226,706 (730 USQP 753); 3,308,590 (744 F.2d 797); Re.30,366 (799 F.2d 734); 4,344,261 (848 F.2d 179); Re.31,746 (870 F.2d 1546); 3,852,579 (872 F.2d 978); 4,664,020 (945 F.2d 1546); 4,628,910 (946 F.2d 850); 4,664,020 (20 USPQ2d 1332);

<sup>11</sup> It would have no significance if patentees brought only strong cases, if the accused refused to settle most weak cases, or if the patentees cases were almost always better presented. Amicus suggests that these are not supportable propositions.

made above. Infringement overwhelmingly involves only a single question.

On the assumption that there is some testimony or other evidence which supports infringement, and if the jury is allowed to answer the sole question, the defence of non-infringement, as a practical matter, is simply removed from the case.<sup>12</sup> From this several consequences flow.

For 125 years the patent law has explicitly required patentees to "distinctly claim" their inventions.<sup>13</sup> Even earlier in 1836, the law required patent applications to be examined, which also required the application to "particularly specify and point out the part, improvement or combination, which he claims as his invention".<sup>14</sup> It is the claim which is examined for patentable novelty, or unobviousness.

For over a century, this Court has repeatedly stated that patents are limited to their claims, *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 247, 278 (1877) (... "courts have no right to enlarge a patent beyond the scope of the claims..."); *Aro Mfg. Co. v. Convertible Top Replacement Co.* 365 U.S. 336, 339 (1961) ("if anything is settled in

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<sup>12</sup> While some JMOLs are granted, and some jury verdicts are reversed on appeal, this is a very weak and uncertain reed, to the actual litigant facing a patent infringement suit before a jury.

<sup>13</sup> Patent Act of 1870, ch. 230, § 26, 16 Stat. 198 (July 8, 1870); now 35 U.S.C. § 112

<sup>14</sup> Patent Act of 1836, ch 357, § 6 5 Stat. 117 (July 4, 1836)



patent law...the combination patent covers only the totality of elements in the claim.")

If juries are at liberty to "construe" the claims, one consequence is that both the will of Congress will be frustrated, and the above quoted statements of this Court will be rendered somewhat hollow.

A second and more serious consequence also flows from this situation. Lawyers retained by those accused of infringement must share this dismal prospect with them. This Court may assume that the prospects on invalidity are equally dim (actually they appear slightly worse).

Thus in most patent jury cases, both the validity and infringement issues are practically unavailable, and the only realistic issue is damages. For recent patents where the real issue is the injunction over the next 15+ years, even the damage issue is not available, and there is no choice but to abandon the new product, or pay the asking price for a license.

This added cost falls entirely on the shoulders of those businesses who are designing and building new products. Either this endeavor is terminated, or the costs are necessarily passed on to the consuming public.

From the turn of the century until a few decades ago, the United States built the products which the world desired. In the last few decades, with rare exceptions, what Americans want, let alone what the rest of the world wants, is supplied by foreign industry. The effect of this turnabout

on the future well being of Americans is apparent.

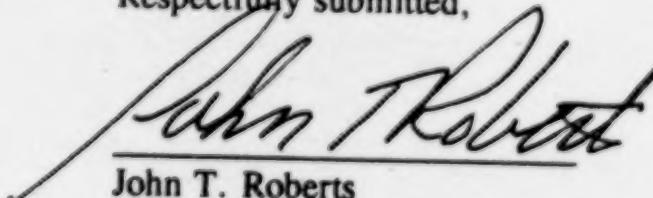
Other amici are here urging this Court to both confirm and expand the role of juries in patent cases. If that occurs, it will impose one more burden on "the progress of the useful arts", which over history has done so much for the United States, but is unarguably already failing in that important task.

## CONCLUSION

This appears a good case for application of the rule that appellate courts should review the holdings, not the rhetoric, of opinions. All of the judges at the Federal Circuit appeared to agree that, when there is only one correct answer to a properly framed infringement question, the judge should answer that question, and rule accordingly.

This Court should first ask itself if the decision of Judge Katz correctly applied the above rule. If this Court concludes that Judge Katz did so, the judgement below should be affirmed.

Respectfully submitted,



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